REMARKS

The Applicants have studied the Office Action dated February 24, 2005 and have made amendments to the independent claims to distinctly claim and particularly point out the subject matter which the Applicants regard as the invention. Applicants have amended the dependent claims to reflect the changes to the independent claims. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 20-37 are pending. Applicants submit that the present response and amendment places the application in condition for allowance or, at least presents the application in better form for appeal. Entry of the present response with amendment is therefore respectfully requested.

In the Office Action, the Examiner:

- rejected claim 20 under 35 U.S.C. §112, second paragraph;

- rejected claims 20-21, 24, 26-27, 30, 32-33, and 36 under 35 U.S.C. § 102(e) as being anticipated by Mahajan et al. (U.S. 6,226,650 B1);

- rejected claims 22-23, 28-29, and 34-35 under 35 U.S.C. § 103(a) as being unpatentable Mahajan et al. (U.S. 6,226,650 B1) in view of Applicant Admitted Prior Art (Background);

- rejected claim 25 under 35 U.S.C 103(a) as being unpatentable over Mahajan et al. (U.S. 6,226,650 B1) and Applicant Admitted Prior Art (Background) as applied to clam 24 above, and further in view of Rackman (U.S. 5,903,646); and

- rejected claims 31 and 37 under 35 U.S.C 103(a) as being unpatentable over Mahajan et al. (U.S. 6,226,650 B1) in view of Rackman (U.S. 5,903,646).

Rejection Under 35 USC § 112, Second Paragraph

As noted above, the Examiner rejected claim 20 under 35 U.S.C. §112, second paragraph. Claim 20 has been amended to overcome this rejection. In particular, the present invention, as recited for claim 20, now more clearly recites "predetermined value". Support for this amendment may be found in the Specification as originally filed. See for example, page 12, lines 9-22. No new matter has been added. The Applicants respectfully submit that the Examiner's rejection has been overcome and the rejection of claim 20 should be withdrawn.

Rejection under 35 U.S.C. §102(e)

As noted above, the Examiner rejected claims 20-21, 24, 26-27,30, 32-33, and 36 under 35 U.S.C. § 102(e) as being anticipated by Mahajan et al. (U.S. 6,226,650 B1). Independent claims 20, 26, and 32 have been amended to distinguish over Mahajan and the dependent claims 21, 24, 27, 30, 33, and 36 have been amended to reflect the changes to the independent claims. Specifically, Mahajan is silent on:

selecting at least one remote database server;

accessing locally on a first database server, at least one database record in a first database, wherein the database record includes at least one field for each of a sequence number field, a problem identifier field, and a work history field;

searching for at least one database record in the first database, with a value in the work history field matching a predetermined value;

using a sequence value within the sequence number field in the at least one database record in the first database, with the value in the work history field matching the predetermined value as a starting point for synchronization with the remote database server, wherein the sequence value in the sequence number field of the at least one database record is associated with the at least one database record;

sending to the remote database server each database record in the first

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database whose <u>associated sequence number in the sequence number field</u> is greater than the sequence value;

 <u>appending at least one new database record directly into the first database with a new value in the work history field matching the predetermined value;</u> and

 storing <u>a new sequence number directly in a sequence number field of</u> the at least one new database record in the first database, <u>wherein the new sequence number is an increment of a final sequence number of a final database record sent to the remote database.</u>

The Examiner concluded that Mahajan teaches the present invention as recited for claims 20, 26, and 32 and cited several paragraphs in Mahajan in support thereof. Applicants respectfully disagree with the Examiner. In particular, the Examiner concluded that Mahajan teaches:

> "accessing locally on a first database server, at least one database record, wherein the database record includes at least one field for each of a sequence number field, a problem identifier field, and a work history field"

As stated above, Applicants have amended independent claims 20, 26, and 32 to more clearly recite:

> "accessing locally on a first database server, at least one database record <u>in a first database</u>, wherein the database record includes at least one field for each of a sequence number field, a problem identifier field, and a work history field"

Support for the above amendment may be found in the Specification as originally filed. See for example, page 6, lines 22-30 to page 7, lines 1-3.

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No new matter was added.

The Examiner's reliance upon the citations of Mahajan is misplaced for the following reasons: col. 16, lines 23-36 merely discloses modification files. Mahajan teaches that data in the server database is divided into groups. See Mahajan at col. 2, lines 59-64. When the modification files are created by the server, they are associated with one of the particular data groups. See for example, Mahajan at col. 3, lines 1-9. The modification files contain all of the operations on the data set that correspond to the changes to group data to which the transmitting client is assigned.

As taught by Mahajan, the modification files are not even in the database, they reside outside the database on the server. See for example, Mahajan at FIG. 2. The server does not access the database in order to retrieve the modification files. Similarly, the client system does not access the server database to retrieve database records either; the server transmits the modification files (which are not database records) to the client system. The modification files in Mahajan are not database records each with fields containing a single entry per field (sequence number, a problem identifier field, and a work history field) as recited for the independent claims of the present invention. Rather the modification files in Mahajan are not limited to one entry per field. Therefore, Mahajan is not "accessing locally on a first database server, <u>at least one database record in a first database</u>", as recited for independent claims 20, 26, and 32. Therefore, claims 20, 26, and 32 distinguish over Mahajan for at least this reason as well.

The Examiner also concluded that Mahajan teaches:

> "searching for at least one database record with a predetermined value in the work history field"

As stated above, Applicants have amended independent claims 20, 26, and 32 to more clearly and distinctly recite:

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"searching for at least one database record in the first database, with a value in the work history field matching a predetermined value"

Support for the above amendment may be found in the Specification as originally filed. See for example, generally page 13, lines 9-22. No new matter was added.

The Examiner states that the transactions A, C, R, and J in the modification files are predetermined values in a work history field and searched by sequence number. As stated above, the transaction letters as illustrated by FIG. 4 of Mahajan are for illustrative purposes only and not for identification purposes. Nowhere does Mahajan suggest, teach, or state that the transactions are predetermined values. A transaction, as taught by Mahajan, is only a representation of a sequence of operations. See Mahajan at col. 8, lines 8-12. This representation of a sequence of operations, i.e. transactions, is not predetermined values. For example, when changes to data occur, a client submits these changes to the server. The server then creates a modification file that is associated with the data group whose data has changed. The modification file includes these changes or transactions. As can be seen, the transactions merely reflect the changes to data submitted by client systems and are not predetermined values.

Additionally, when a client system requests an update from the server, Mahajan teaches that the client system sends the server the sequence number associated with the last modification file that was sent to the client system. However, this sequence number is not the global transaction number as illustrated in FIG. 4, it is the sequence number disclosed in col. 6, lines 23-36 of Mahajan. As discussed above, this sequence number is only associated with the modification file and Mahajan does not teach where this associated sequence number is stored. The global transaction number identifies a particular transaction, not a particular modification file. See Mahajan at col. 8, lines 3-8. In fact, the global transaction numbers in Mahajan are not even searched; they only

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are used to notify the client system of the order that the transactions took place. See Mahajan at col. 8, lines 3-8. Nowhere does Mahajan teach, anticipate, or even suggest "<u>searching for at least one database record in the first database with a value in the work history field matching a predetermined value</u>", as recited for claims 20, 26, and 32. Therefore, claims 20, 26, and 32 distinguish over Mahajan for at least this reason as well.

The Examiner also concluded that Mahajan teaches:

"using a sequence value within the sequence number field in the at least one database record with the predetermined value as a starting point for synchronization with the remote database server".

As stated above, Applicants have amended claims 20, 26, and 32 to more clearly and distinctly recite:

"using a sequence value within the sequence number field in the at least one database record <u>in the first database</u> with the value <u>in the work history field matching the predetermined value</u> as a starting point for synchronization with the remote database server, <u>wherein the sequence value in the sequence number field of the at least one database record is associated with the at least one database record</u>"

Support for the above amendment may be found in the Specification as originally filed. See for example, page 6, lines 22-30 to page 7, lines 1-3 and page 13, lines 9-22. No new matter was added.

The Applicants respectfully disagree with the Examiner's conclusion that Mahajan teaches the above claim element. The Examiner's reliance upon the citations of Mahajan is misplaced for the following reasons: col. 6, lines 30-36

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merely discloses that the server only sends a modification file that has a sequence number greater than the sequence number transmitted by the client system. As discussed above, the sequence number associated with the modification file is the sequence number disclosed in col. 6, lines 23-36 of Mahajan. Mahajan does not teach, anticipate, or even suggest that the sequence number associated with the modification file is in a sequence number field.[1] Only the global transaction number is stored in a global transaction number field. The global transaction number or transaction section of the modification file is not used when searching for the most recent modification file, only the sequence number that is associated with the modification file is used.

When the client system receives the modification file it has to filter out all of the duplicated data or data that the client system does not have permission to access. See for example, Mahajan at col. 8, lines 35-54. One of the advantages of the present invention is that by using a sequence value with the value in the work history field matching the predetermined value as a starting point for synchronization, duplicated data will not be transmitted. Therefore, Mahajan does not teach, anticipate, or even suggest "using a sequence value within the sequence number field in the at least one database record in the first database, with the value in the work history field matching the predetermined value as a starting point for synchronization with the remote database server, wherein the sequence value in the sequence number field of the at least one database record is associated with the at least one database record", as now recited for

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[1] See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

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claims 20, 26, and 32. Accordingly, claims 20, 26, and 32 distinguish over Mahajan for at least this reason as well.

The Examiner also concluded that Mahajan teaches:

"appending at least one new record in the first database with the predetermined identifier value in the work history field".

As stated above, Applicants have amended claims 20, 26, and 32 to more clearly and distinctly recite:

"appending at least one new <u>database</u> record <u>directly into</u> the first database with <u>a new value in the work history field matching the predetermined value</u>"

Support for the above amendment may be found in the Specification as originally filed. See for example, page 6, lines 22-30 to page 7, lines 1-3. No new matter was added.

The Examiner states that the modification file, as a new record, is appended in the database management system. Applicants respectfully disagree with the Examiner's conclusion that Mahajan teaches the above claim element. As discussed above, the modification file in Mahajan is not a database record nor is the modification file even in the server database. Also, as discussed above, Mahajan fails to teach a predetermined a value in a work history field matching a predetermined value. <u>Therefore, Mahajan does teach, anticipate, or suggest "appending at least one new database record directly into the first database with a new value in the work history field matching the predetermined value"</u>. Accordingly, claims 20, 26, and 32 distinguish over Mahajan for at least this reason as well.

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The Examiner also concluded that Mahajan teaches:

> "storing a new sequence number in the at least one new record in
> the first database, wherein the new sequence number is an
> increment of a final sequence number of a final database record
> sent to the remote database"

As stated above, Applicants have amended claims 20, 26, and 32 to more clearly
recite:

> "storing a new sequence number <u>directly in a sequence number
> field of</u> the at least one new <u>database</u> record in the first database,
> wherein the new sequence number is an increment of a final
> sequence number of a final database record sent to the remote
> database"

Support for the above amendment may be found in the Specification as
originally filed. See for example, page 16, lines 21-29 to page 17, lines 1-
6. No new matter was added.

Applicants respectfully disagree with the Examiner's conclusion that Mahajan
teaches the above claim element. As discussed above, Mahajan only teaches
that a sequence number is associated with a modification file and does not teach
where this sequence number is stored. Therefore, Mahajan does not teach,
anticipate, or suggest "<u>storing a new sequence number directly in a sequence
number field of the at least one new database record in the first database,
wherein the new sequence number is an increment of a final sequence number
of a final database record sent to the remote database</u>". Accordingly, claims 20,
26, and 32 distinguish over Mahajan for at least this reason as well.

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Additionally, claims 21, 24, 27, 30, 33, and 36 depend from claims 20, 26, and 32 respectively and, since dependent claims recite all of the limitations of the independent claim; it is believed that, therefore, claims 21, 24, 27, 30, 33, and 36 also recite in allowable form.

Therefore, in view of the foregoing remarks, Applicants believe that the rejection of claims 20-21, 24, 26-27, 30, 32-33, and 36 under 35 U.S.C. § 102(e) has been overcome. Applicants request that the Examiner allow claims 20-21, 24, 26-27, 30, 32-33, and 36.

Rejection under 35 U.S.C. §103(a) Mahajan in view of Admitted Prior Art

As noted above, the Examiner rejected claims 22-23, 28-29, and 34-45 under 35 U.S.C. § 103(a) as being unpatentable Mahajan et al. (U.S. 6,226,650 B1) in view of Applicant Admitted Prior Art (Background). The Examiner goes on to combine Mahajan with the Admitted Prior Art found the Background section of the Specification as originally filed.[2] The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." As described in the section entitled "Rejection under 35 U.S.C. §102(e), the Mahajan reference taken alone or in view of the Admitted Prior Art simply does <u>not</u> teach, anticipate, or suggest the patentably distinct limitation of:

      selecting at least one remote database server;

      accessing locally on a first database server, <u>at least one database record in a first database</u>, wherein the database record includes at least one field for each of a sequence number field, a problem identifier field, and a work history field;

      searching for at least one database record <u>in the first database,</u>

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[2] Applicants make no statement whether such combination is even proper.

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with a value in the work history field matching a predetermined value;

using a sequence value within the sequence number field in the at least one database record in the first database, with the value in the work history field matching the predetermined value as a starting point for synchronization with the remote database server, wherein the sequence value in the sequence number field of the at least one database record is associated with the at least one database record;

sending to the remote database server each database record in the first database whose associated sequence number in the sequence number field is greater than the sequence value;

appending at least one new database record directly into the first database with a new value in the work history field matching the predetermined value; and

storing a new sequence number directly in a sequence number field of the at least one new database record in the first database, wherein the new sequence number is an increment of a final sequence number of a final database record sent to the remote database.

The limitations taken "as a whole" in independent claims 20, 26, and 32 are not present in Mahajan taken alone or in view of the Admitted Prior Art. Accordingly, the present invention is distinguishable over Mahajan in view of the Admitted Prior Art for at least this reason.

Moreover, The Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here, Mahajan teaches a sequence number that is associated with the modification file; Mahajan is silent on and does not teach, suggest or disclose that the sequence number is in a sequence number field. In Mahajan, the modification files are different for each group of data, resulting in the

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client systems keeping track of different modification file sequence numbers. In the presently claimed invention, however, the sequence numbers are located in a sequence number field of every record. Each database contains identical information regarding the sequence numbers so that the databases can be easily synchronized with each other by using the sequence number field. Therefore, the combination of the Admitted Prior Art with Mahajan to produce the presently claimed invention would produce an inoperative device because the client systems in Mahajan do not contain the same information regarding sequence numbers and the modification file sequence numbers are not taught to be in a sequence number field. Accordingly, the combination of Mahajan and the Admitted Prior Art results in an inoperable system, and the Examiner's case of *"Prima Facie Obviousness"* should be withdrawn.

Moreover, the Federal Circuit stated in <u>McGinley v. Franklin Sports, Inc.</u>, (Fed Cir 2001) that if references taken in combination would produce a "seemingly inoperative device," such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness. <u>In re Sponnoble</u>, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); <u>see also</u> <u>In re Gordon</u>, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away). Here, Mahajan teaches a sequence number that is associated with the modification file; Mahajan never mentions that the sequence number is in a sequence number field. The modification files are different for each group of data, resulting in the client systems keeping track of different modification file sequence numbers. In the presently claimed invention, the sequence numbers are located in a sequence number field of every record. Each database contains identical information regarding the sequence numbers so that each database includes the same synchronized information. Therefore, the combination of the Admitted Prior Art with Mahajan to produce the presently claimed invention would produce an inoperative device. Accordingly, the combination of Mahajan and the Admitted Prior Art is improper.

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Therefore, in view of the foregoing remarks, Applicants believe that the rejection of claims 22-23, 28-29, and 34-45 under 35 U.S.C. § 103(a) has been overcome. Applicants request that the Examiner allow claims 22-23, 28-29, and 34-45.

Rejection under 35 U.S.C. §103(a) Mahajan in view of Admitted Prior Art in further view of Rackman

As noted above, the Examiner rejected claim 25 under 35 U.S.C 103(a) as being unpatentable over Mahajan et al. (U.S. 6,226,650 B1) and Applicant Admitted Prior Art (Background) as applied to clam 24 above, and further in view of Rackman (U.S. 5,903,646). The Examiner goes on to combine Mahajan with the Applicant Admitted Prior Art in further view of Rackman.[3] The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." The Mahajan reference taken alone or in view of the Admitted Prior Art or Rackman simply does <u>not</u> teach, anticipate, or suggest the patentably distinct claim elements of independent claim 20, which have been discussed above in the section entitled "Rejection under 35 U.S.C. §102(e)".

Rackman discloses an access control system for litigation document production. See Rackman at Abstract. Nowhere does Rackman teach the presently claimed invention as recited for claim 1. Therefore, the limitations taken "as a whole" in independent claim 20 and accordingly claim 25, which depends from claim 20, are not present in Mahajan taken alone or in view of the Applicant Admitted Art and further in view of Rackman. Additionally, the inoperable argument discussed above in the section entitled "Rejection under 35 U.S.C. §103(a) Mahajan in view of Admitted Prior Art" is applicable here and will not be repeated.

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[3] Applicants make no statement whether such combination is even proper.

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Therefore, in view of the foregoing remarks, Applicants believe that the rejection of claim 25 under 35 U.S.C. § 103(a) has been overcome. Applicants request that the Examiner allow claim 25.

Rejection under 35 U.S.C. §103(a) Mahajan in view of Rackman

As noted above, the Examiner rejected claims 31 and 37 under 35 U.S.C 103(a) as being unpatentable over Mahajan et al. (U.S. 6,226,650 B1) in view of Rackman (U.S. 5,903,646). The Examiner goes on to combine Mahajan with Rackman.[4] The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." The Mahajan reference taken alone or in view Rackman simply does <u>not</u> teach, anticipate, or suggest the patentably distinct claim elements of independent claims 26 and 32, which have been discussed above in the sections entitled "Rejection under 35 U.S.C. §102(e)" and "Rejection under 35 U.S.C. §103(a) Mahajan in view of Admitted Prior Art", respectively. Therefore, the limitations taken "as a whole" in independent claims 26 and 32 and accordingly claims 31 and 37, which depend from claims 26 and 32, are not present in Mahajan taken alone or in view of Rackman. Additionally, the inoperable argument discussed above in the section entitled "Rejection under 35 U.S.C. §103(a) Mahajan in view of Admitted Prior Art" is applicable here and will not be repeated.

Therefore, in view of the foregoing remarks, Applicants believe that the rejection of claims 31 and 37 under 35 U.S.C. § 103(a) has been overcome. Applicants request that the Examiner allow claims 31 and 37.

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[4] Applicants make no statement whether such combination is even proper.

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CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

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PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully Submitted,

Date: April 25 , 2005

By:_____

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